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09/427,263	10/26/1999	RICHARD HANS HARVEY	Q56191	2940

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EXAMINER	
ALAM, HOSAIN T	
ART UNIT	PAPER NUMBER
2172	10

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/427,263	HARVEY, RICHARD HANS	
	Examiner	Art Unit	
	Hosain T Alam	2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,12,31-35,41,56-58 and 60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,12,31-35,41,56-58 and 60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *9* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This Office Action is in response to the amendment filed on March 5, 2003, Paper No. 8. Claim 61 has been canceled. Claims 1-5, 12, 31-35, 41, 56-58, and 60 are pending in this Action.

Applicant's statements and/or arguments regarding the restriction requirements have been considered, however they are not persuasive. The restriction set forth in the previous action hereby maintained.

The information disclosure statements (IDS) filed in Paper No. 9 has been considered.

Applicant has indicated that a terminal disclaimer might be filed to overcome the rejection of claims 1-5, 12, 31-35, 41, 56-58, and 60 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,052,681 issued to Harvey.

The rejection of claims 56 and 61 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as set forth in Paper No. 6, is hereby withdrawn.

Status of the Claims

Claim 61 has been canceled. Claims 1-5, 12, 31-35, 41, 56-58, and 60 have been amended. Claims 1-5, 12, 31-35, 41, 56-58, and 60 are pending in this Action.

Response to Arguments

Applicant's arguments filed in Paper No. 8 have been fully considered but they are not persuasive. The reasons are given below.

Argument (1): In page 7, the bottom paragraph, the applicant argues that Leung uses a single entry table and that Leung is not based on an object-oriented model. The applicant also asserts that Leung is deficient in its implementation of X.500 protocol because it is a prototype.

Response: The issue is not whether the Leung reference discussed a prototype but whether it provides the descriptions that can be used by one of ordinary skill in the art to arrive at the invention. Leung provides a description of each of the claimed elements and each of the descriptions is understandable by one of ordinary skill in the art for the purpose of anticipation, implicit disclosure and/or inherent anticipation.

Schering Corp. v. Geneva Pharmaceuticals Inc., 64 USPQ2d 1032 (DC NJ 2002), decided August 8, 2002. The prior art disclosure need not be express in order to anticipate. Even if a prior art inventor does not recognize a function of his or her process, the process can anticipate if that function was inherent. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation.
Reference: is made to MPEP 2144.01 - Implicit Disclosure "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)

The applicant has pointed to selected sections of the Leung reference wherein a prototype has been referred to, but ignored other relevant teachings.

Claim 1, to which is the arguments seem to be directed to is provided below:

A method of storing data in a database, the method comprising the steps of:

obtaining both a protocol-encoded protocol-encoded form of data to be stored and a syntax-syntax-normalised form of said data; and

storing concurrently both the syntax-syntax-normalised form and protocol-encoded protocol-encoded form of said data.

The examiner submits that claim 1 does not require two entry tables but a database that stores both the syntax-syntax-normalised data and protocol-encoded protocol-encoded data concurrently.

The applicant therefore mischaracterizes the Leung reference. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Argument (2): In page 8, 2nd paragraph, the applicant asserts that Leung is not a description of anything that occurred in the United States.

Response: In accordance with 35 USC 102(b), the examiner respectfully submits that the invention was described in a printed publication in a foreign country more than one year prior to the date of application for patent in the United States. The Leung reference is a printed publication in a foreign country.

Argument (3): In page 8, the bottom paragraph, the applicant asserts that Leung does not teach at least two tables.

Response: Claim 1 does not require two tables, but the amended claim 3 does.

Contrary to the above assertion, Leung teaches at least two table as claimed. Leung, in Fig. 6, shows a table namely, "ENTRY". In the "ENTRY" table, Leung shows two elements "Norm-value" and "Raw-value". This reads on the claimed step of "storing concurrently both the syntax-normalised form and protocol-encoded raw form of said data" as recited in claim 1, because the "Norm-value" and "Raw-value" are equated with the "syntax-normalised form" and "protocol-encoded raw form" respectively.

See page 739, col. 2, 1st paragraph: The "ENTRY" table holds detailed information about each directory object.

See also, page 737, col. 1, 2nd par., lines 3-9: "The Directory Information Base (DIB) is a logical database composed of directory entries, each of which is a collection of information on one directory object. Each object belongs to one or more object classes."

See also page 738, col. 1, 2nd par., col. 2, 1st par.: "DIBP is an object-oriented database built on top of a commercial relational database management system"

Leung therefore teaches directory objects that are mapped to the attributes in a relational database in X.500-compatiable system. Since Leung treats the entries in the directory as objects, each object can be mapped to one or more tables. What has been shown in Fig. 6, "ENTRY" is an exemplary table wherein both protocol-encoded and syntax-normalised data are concurrently stored for one objects. However such a row/table can be done for any number of objects. Thus Leung teaches multiple tables as required by the claims.

and it is clearly showing on page 738, lines 1-2.

The applicant appears to be arguing the elements of amended claim 3. In the above discussion the examiner however has provided the relevant teachings of Leung as to claim 3.

Argument (4): Applicant's argument that Leung is a prototype and therefore not enabling is irrelevant because the examiner has pointed to the descriptions provided by Leung. And the applicants has not given any reason as to why these descriptions are not adequate, but rather points to certain sections of the Leung reference only to find it not teaching the claimed invention.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 12, 31-35, 41, 56-58, and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by the publication, "An Object-Oriented Approach to Directory Systems," by C.M.R. Leung, IEEE Region 10 Conference on Computer and Communications Systems, September, 1990, Hong Kong, pages 736-740, hereinafter, "Leung."

Leung teaches:

As claim 1, a method of storing data in a database as claimed comprising the steps of obtaining both a protocol-encoded form of data to be stored and a syntax-normalised form of said data; and storing both the syntax-normalised form and protocol-encoded form of said data (Page 738, col. 2, Figure 6).

As to claim 2, first obtaining the a protocol-encoded form of data; and then generating a syntax-normalised form of data (page 738, col. 2).

As to claim 3, maintaining both the syntax-normalised and protocol-encoded form of data for database searching and data retrieval (page 738, col. 2, the 1st paragraph).

As to claim 4, maintaining both the syntax-normalised and protocol-encoded form of data for database searching and data in a table (Figure 6 of page 738, col. 2, shows tables).

As to claim 5, correlating the storage location of said protocol-encoded form and said syntax-normalised form in the table (Figure 6 of page 738, col. 2, shows tables).

As to claim 12, a method of locating data in a database wherein the data is stored linked to a syntax-normalised form of the data and comprising the step of locating said data by searching on said syntax-normalised form of the data (page 738, col. 2, Figure 6).

Claims 31-35 are essentially the same as claims 1-5 except that they set forth the claimed invention as an apparatus rather than a method and rejected for the same reasons as applied above.

Claims 41 is essentially the same as claim 12 except it sets forth the claimed invention as an apparatus rather than a method and rejected for the same reasons as applied above.

Leung further teaches:

As to claim 56, an apparatus for transferring data in and out of a database for a directory service system wherein the data is stored in protocol-encoded form and in syntax-normalised from as claimed comprising means for finding data in the database using a syntax-normalised form; and means for transferring data out of the database using a protocol-encoded form (Page 738, col. 2, Figure 6).

Claims 57 is essentially the same as claim 1 except it sets forth the claimed invention as a computer program product rather than a method and rejected for the same reasons as applied above.

As to claims 58 and 60 which further limit the protocol-encoded form as being ASN.1 formats, see Leung, page 736, col. 1 and 2, Sections, "Introduction" and "Directory Systems" that detail various directory services standards.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosain T Alam whose telephone number is (703) 308-6662. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6606 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305 3800. The following contact

numbers may also be used:

TC 2100 After Finals number is 703-746-7238

TC 2100 Official Fax number is 703-746-7239

TC 2100 Customer Service Center is 703-746-7240

Hosain T Alam
Primary Examiner
Art Unit 2172

May 9, 2003